

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL D. HOCKER and DANIEL J. WINARSKI

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Appeal No. 1997-4068  
Application No. 08/296,219<sup>1</sup>

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ON BRIEF

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Before URYNOWICZ, BARRETT, and FLEMING, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

Decision on Appeal

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<sup>1</sup> Application for patent filed August 25, 1994.

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This appeal is from the final rejection of claims 3-8,  
all the claims pending in the application.

The invention pertains to a hand-held data storage unit.  
Claim 8, the only independent claim, is illustrative and reads  
as follows:

8. A system for transferring data between  
one or more computer systems, comprising in  
combination:

a portable, hand-held, data storage unit,  
including a microprocessor, a solid-state memory  
means operatively coupled to said  
microprocessor, a communications port  
operatively connected to said microprocessor,  
and means including said microprocessor for  
generating graphical user interface control  
signals;

a computer systems with a graphical user  
interface application program responsive to said  
graphical user interface control signals;

said computer system transmitting data to  
said microprocessor via said communication port  
in response to said graphical user interface  
control signals;

said microprocessor storing said data in  
said solid-state storage means; and

said microprocessor transmitting said data  
stored in said memory to said computer system.

The references relied upon by the examiner are:

McLaughlin et al. (McLaughlin)      3,941,989      Mar. 02,  
1976

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Asano et al. (Asano)	4,853,682	Aug. 01,
1989		
Glynn	5,181,181	Jan. 19,
1993		

Claims 3-5 and 8 are provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending application Serial No. 08/451,803 in view of Glynn.

Claims 6 and 7 are provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending application Serial No. 08/451,803 in view of Glynn and McLaughlin.

Claims 3-5 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Glynn in view of Asano.

Claims 6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over Glynn in view of Asano as applied to claims 3-5 and 8, further in view of McLaughlin.

The respective positions of the examiner and the appellants with regard to the propriety of these rejections are set forth in the final rejection (Paper No. 6) and the

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examiner's answer (Paper No. 11) and the appellants' brief (Paper No. 10) and reply brief (Paper No. 12).

### Opinion

We will not sustain the provisional rejection of claims 3-5 and 8 over claim 2 of application Serial No. 08/451,803 in view of Glynn or the provisional rejection of claims 6 and 7 over claim 2 of application Serial No. 08/451,803 in view of Glynn and McLaughlin. According to U.S. Patent and Trademark Office records, application Serial No. 08/451,803 is now abandoned. Accordingly, claim 2 thereof is no longer evidence on which a double patenting rejection can be based.

We will not sustain the rejection of claims 3-5 and 8 under 35 U.S.C. § 103 over Glynn in view of Asano. We agree with appellants that neither reference teaches or suggests that data transferred to a portable, hand-held data storage unit from a computer system in response to user control signals is transferred back to the computer system. The examiner concedes to the effect that Glynn does not disclose transmitting the stored command data back to the computer 23 from the data processing mouse 1. As noted by the examiner,

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Asano teaches transmitting data from a wristwatch B to a central processing system A. However, there is no teaching in Asano that this data is data which had been transferred from the central processing system to the wristwatch in response to user control signals. Accordingly, even assuming motivation to combine Glynn and Asano exists, the combination does not produce the claimed invention. Otherwise, a case for obvious modification of the combination of Glynn and Asano which would have rendered the claims unpatentable has not been set forth by the examiner.

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Whereas we will not sustain the rejection of claims 3-5  
and 8 over Glynn and Asano, we will not sustain the rejection  
of dependent claims 6 and 7 over Glynn, Asano and McLaughlin.

REVERSED

STANLEY M. URYNOWICZ, JR	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	

SMU/sld

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Appeal No. 1997-4067

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APJ URYNOWICZ

APJ BARRETT

APJ FLEMING

REVERSED

Prepared: December 6, 2000